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10/611,781

06/30/2003

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EXAMINER

LOFTUS, ANN E

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

08/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/611,781 | Applicant(s) KEIS ET AL. | |
| | Examiner Ann Loftus | Art Unit 3694 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/30/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/21/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The words currency and exchange together give the impression that converting dollars to yen, for example, would be relevant, whereas the invention is directed more towards financial institution middleware or banking internal transaction routing.

Drawings

2. The drawings are objected to because manager is misspelled in block 112 Fig. 1 and block 302 Fig. 3. Further the specification on page 4 paragraph 14 describing Fig. 1 refers to a "payment manager" instead of a "payment out manger" and also a "financial institution validator" instead of a "financial institution manager."

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

3. The references in the IDS filed 10/21/2003 were considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, the role of the financial transaction manager is not sufficiently distinct from the remittance processor and the payment manager. Which one would handle incoming and outgoing transactions? The specification seems to give the financial transaction manager a role in internal transactions, as opposed to external transactions handled by the remittance processor and the payment manager. But that is not indicated in the claim, leaving the roles unclear. The metes and bounds of the claim

are not clear, thus the claim is rejected. The remaining claims are rejected as depending upon a rejected parent.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5483445 filed 21 Oct 1993 by Pickering, in view of US Patent No 6578015 filed 31 Aug 1999 by Haseltine et al, and further in view of US Patent No 5504677 filed Oct 15 1992 by Pollin.

As to claim 1, Pickering teaches a remittance processor configured to process incoming payments in lines 55-68 col 13. Pickering teaches an electronic payment processor configured to process outgoing electronic payments in col 12 line 50. Pickering teaches a request processor (communications manager) in Figure 1. Pickering does not specifically teach a transaction manager. Haseltine teaches a financial transaction manager configured to process and execute various financial transactions in Fig 2. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pickering to add a transaction manager in order to manage internal account transfers.

The Pickering Haseltine combination does not specifically teach a financial institution validator. Pollin teaches a financial institution validator configured to validate data regarding external institutions in col 9 lines 45-68. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine combination to add a financial institution validator configured to validate data regarding external institutions in order to ensure that financial institution data is correct and current.

The Pickering Haseltine combination does not specifically teach an arrangement manager. Pollin teaches an arrangement manager(scheduler) configured to perform specified periodic events in col 4 lines 18-22. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine combination to add an arrangement manager(scheduler) configured to perform specified periodic events in order to avoid errors from manually triggering periodic events.

The Pickering Haseltine combination does not specifically teach a check writing manager. Pollin teaches a check writing manager configured to process checks in items 216 and 218 of Fig. 2, described in col 12 line 38 to col 13 line 53. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine combination to add a check writing manager configured to process checks in order to satisfy customers who wish to be paid by check.

As to claim 3, the Pickering Haseltine combination does not specifically teach a message system. Pollin teaches a message system in block 210 of Figure 2. It would

have been obvious to a person of ordinary skill in the art to modify the Pickering Haseltine combination to add communication via a messaging in order to let operators and other systems know of events that occur.

As to claim 8, the Pickering Haseltine combination does not specifically teach creating periodic arrangements, validating arrangements against pre-determined criteria, storing arrangements, including a scheduled date, comparing a current date with scheduled dates, and transmitting messages regarding scheduled arrangements. Pollin teaches creating periodic arrangements, validating arrangements against pre-determined criteria, storing arrangements, including a scheduled date, comparing a current date with scheduled dates, and transmitting messages regarding scheduled arrangements. It would have been obvious to a person of ordinary skill in the art to modify the Pickering Haseltine combination to add creating periodic arrangements, validating arrangements against pre-determined criteria, storing arrangements, including a scheduled date, comparing a current date with scheduled dates, and transmitting messages regarding scheduled arrangements in order to support a scheduling function for routine transaction instead of manually re-entering them or trying to remember to execute them at the proper time.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering, and Haseltine and Pollin, further in view of US Patent No. 6493680 filed 19 Feb 1998 by Logan et al.

As to claim 2, Pollin teaches a front-end in col 15 line 20, but the Pickering Haseltine Pollin combination does not specifically teach an internal and external front-end. Logan teaches a front-end (interface component) for internal use and a front-end for external use in col 4 lines 50-60. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine Pollin combination to add a front-end for internal use and a front-end for external use because it allows each group of users to have the tools and data they use presented in a useful way.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering, and Haseltine and Pollin, further in view of US Patent No. 5930778 filed 11 July 1996 by Geer.

As to claim 4, the Pickering Haseltine Pollin combination does not specifically teach scanning a remittance and assigning an identifier. Geer teaches in claim 15 scanning incoming remittances into electronic format, assigning a unique identifier to each remittance, and storing said unique identifier with data regarding the incoming remittance. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine Pollin combination to add scanning incoming remittances into electronic format, assigning a unique identifier to each remittance, and storing said unique identifier with data regarding the incoming remittance because it enables electronic processing of the remittance, and allows easier retrieval of the remittance data than filing the paper copy.

10. Claims 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering, and Haseltine and Pollin, further in view of US Patent No. 5220501 filed 8 Dec 1989 by Lawlor.

As to claim 5, the Pickering Haseltine Pollin combination does not specifically teach translating instructions. In col 21 lines 3-20 Lawlor teaches receiving instructions from a request processor, translating the instructions into a format readable by another system and transmitting the translated instructions to another system. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine Pollin combination to add receiving instructions from a request processor, translating the instructions into a format readable by another system and transmitting the translated instructions to another system because the process of settling transactions requires communications with many systems and translation would enable more transactions to be processed.

As to claim 7, the Pickering Haseltine Pollin combination does not specifically teach receiving a request to perform an electronic transaction, formatting said request into a form usable by an electronic payment network, sending said formatted request to an electronic payment network and storing data regarding each request in a database. In col 21 lines 3-20 Lawlor teaches receiving a request to perform an electronic transaction, formatting said request into a form usable by an electronic payment network, sending said formatted request to an electronic payment network and storing data regarding each request in a database. It would have been obvious to a person of

ordinary skill in the art at the time of the invention to modify the Pickering Haseltine Pollin combination to add receiving a request to perform an electronic transaction, formatting said request into a form usable by an electronic payment network, sending said formatted request to an electronic payment network and storing data regarding each request in a database because the ability to reformat transactions would enable more transactions to be processed and storing the data would provide a record for later verification.

As to claim 9, Pickering does not specifically teach validating transactions. Haseltine teaches validating transactions in col 6 lines 57-65. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pickering to add validating transactions because that way errors would be identified and appropriate alerts and actions could be started. The Pickering Haseltine Pollin combination does not specifically teach directing transactions to an appropriate component. Lawlor col 20 lines 11 –29 teaches directing transactions to an appropriate component. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine Pollin combination to add directing transactions to an appropriate component in order to avoid the overhead of excess processing if all systems were to receive all transactions.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering, and Haseltine and Pollin, further in view of Official Notice.

As to claim 6, the Pickering Haseltine combination does not specifically teach check writing. Pollin teaches in col 12 line 38 to col 13 line 54 receiving a request to write a check, formatting said request, and sending a print request to a printer. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine combination to add receiving a request to write a check, formatting said request, and sending a print request to a printer in order to be able to make payments to entities who wish to be paid by check. The Pickering Haseltine Pollin combination does not specifically teach storing data regarding each print request in a database. Official Notice is taken that businesses keep records of checks printed for audits and to prevent fraud. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Pickering Haseltine Pollin combination to add storing data regarding each print request in a database in order to have a record of each check printed to prevent fraud and for audits.

Conclusion

12. The examiner notes that it is old and well-known to refactor software, thus moving functionality from one module to another for various reasons.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL
7/30/07


ELLA COLBERT
PRIMARY EXAMINER